

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed December 15, 2004. Applicants respectfully request reconsideration and favorable action in this case in view of the following remarks.

Section 103(a) Rejections

The Office Action rejects Claims 1, 2, 5-10, 13-19 and 22-27 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,116,741 issued to Paschal ("*Paschal*") in view of U.S. Patent No. 6,024,454 issued to Horan et al. ("*Horan*"). The Office Action also rejects Claims 3, 4, 11, 12, 20 and 21 under 35 U.S.C. §103(a) as being unpatentable over *Paschal* in view of *Horan* and further in view of U.S. Patent No. 3,528,720 issued to Treace ("*Treace*"). Applicants respectfully traverse these rejections for the reasons stated below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143.

Applicants respectfully submit that the Examiner has not provided the required evidence of a motivation to combine *Paschal* and *Horan*. As mandated by the Federal Circuit, "[a] factual inquiry whether to combine references must be thorough and searching." *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Any "conclusory statements . . . do not adequately address the issue of motivation to combine." *Id.* The Examiner simply states at pages 3 and 4 of the Office Action that "[i]t would have been obvious to a person of ordinary skill in the art to combine the teachings of *Paschal* and *Horan* et al. to provide a housing for the angled protective lens. One of ordinary skill in the art would have been motivated to do this [to] allow the lens to be more easily handled during replacement or cleaning and thus allowing the lens to be placed and cleaned without accidentally scratching or marking the surface of the lens." This statement is merely a perceived advantage of the proposed combination; there is simply no "factual inquiry" in this statement. Thus, this reasoning surely cannot be said to be "thorough and searching."

In any event, Applicants respectfully submit that a skilled artisan would not be motivated to combine *Paschal* and *Horan* because of some of the following differences when comparing *Paschal* and *Horan*:

<i>Paschal</i>	<i>Horan</i>
<ul style="list-style-type: none">• vertical securing of lens via lens supports 323• lens supports 323 resilient• angled lens 310• lens 310 fully rotatable• first adapter 300 fits inside second adapter 450• first adapter 300 has dilatable seal aperture 325	<ul style="list-style-type: none">• horizontal securing of lens via fittings 36• fittings 36 not resilient (i.e., rigid)• horizontal lens 34• lens 34 not rotatable• first adapter 26 fits outside second adapter 22• first adapter 26 has no seal aperture

Thus, *Paschal* and *Horan* have many differences (examples of which are shown above in the table) that cause them to function much differently. In addition, combining *Paschal* and *Horan* would result in a “substantial reconstruction and redesign of the elements shown in *Paschal*,” (See MPEP § 2143.01), which is not allowed. Thus, there is no motivation to one having ordinary skill in the art to make the proposed *Paschal* and *Horan* combination. For at least this reason, a *prima facie* case of obviousness has not been established with respect to independent Claims 1, 6, 14 and 23. Reconsideration and favorable action are respectfully requested.

Dependent Claims 2-5 depend from independent Claim 1, dependent Claims 7-13 depend from independent Claim 6, dependent Claims 15-22 depend from independent Claim 14, and dependent Claims 24-27 depend from independent Claim 23. These dependent claims are also not rendered obvious by the *Paschal* – *Horan* combination proposed by the Examiner because they include the limitations of their respective base claim as well as additional limitations that further distinguish *Paschal* and *Horan*. Reconsideration and favorable action are respectfully requested.


CONCLUSIONS

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fee is due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. **02-0384** of **Baker Botts L.L.P.**

Respectfully submitted,

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